SECTION II—REMARKS

The following remarks are provided in response to the Office Action mailed July 13, 2006 in which the PTO:

- rejected claims 1-6, 9-10, 12, 14, 18, 21-25, 31, 34-40, 43, 44, 46, 48, 52, 55-65, 67, 69, 73, 76-85, 87-93, and 95-121 under 35 U.S.C. § 102(b) as being anticipated by US Patent 5,790,935 to Payton ("Payton").
- rejected claims 7 and 41 under 35 U.S.C. § 103(a) as being unpatentable over Payton in view of US 6,271,893 to Kawaguchi ("Kawaguchi").
- rejected claims 8, 42, 86, and 94 under 35 U.S.C. § 103(a) as being unpatentable over Payton in view of US 5,853,576 to Perlman et al ("Perlman").
- rejected claims 11, 45, and 66 under 35 U.S.C. § 103(a) as being unpatentable over Payton in view of US 6,067,564 to Urakoshi et al ("Urakoshi").
- rejected claims 13, 15, 16, 26, 28-29, 47, 49-50, 68, and 70-71 under 35 U.S.C. § 103(a) as being unpatentable over Payton in view of US 6,185,360 to Inoue ("Inoue").
- rejected claims 20, 33, 54, and 75 under 35 U.S.C. § 103(a) as being unpatentable over Payton in view of US 5,754,938 to Herz ("Herz").
- rejected claims 17, 30, 51, and 72 under 35 U.S.C. § 103(a) as being unpatentable over Payton in view of US 6,526,575 to McCoy et al ("McCoy").
- rejected claims 19, 32, 53, and 74 under 35 U.S.C. § 103(a) as being unpatentable over Payton in view of US 6,614,987 to Ismail et al ("Ismail").

Applicant thanks the Examiner for a thorough review, and respectfully requests reconsideration of the above referenced patent application for the following reasons:

Claims rejected under 35 U.S.C. § 102(b)

Claims 1-6, 9-10, 12, 14, 18, 21-25, 31, 34-40, 43, 44, 46, 48, 52, 55-65, 67, 69, 73, 76-85, 87-93, and 95-121 are rejected under 35 U.S.C. § 102(b) as being anticipated by Payton.

A claim is anticipated only if each and every element of the claim is found in a single reference. M.P.E.P § 2131 (citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628 (Fed. Cir. 1987)). "The identical invention must be shown in as complete detail as is contained in the claim." M.P.E.P. § 2131 (citing *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226 (Fed. Cir. 1989)).

With regard to independent claims 1, 35, 59, 80, 90, 98, 106, and 113: Claim 1 as amended herein, incorporates intervening claim 11, and now recites in pertinent part, a method wherein:

> "... the content descriptors further include **data pertaining to a revenue-generating potential** of at least a portion of the content pieces ... performing a ranking algorithm to rank at least a portion of the plurality of content pieces **based at least in part on the content descriptors, including the data pertaining to the revenue-generating potential**, to generate a ranking feedback... ."

Refer also to page 13, lines 2-8 of the original specification which teaches in pertinent part:

> "In various embodiments, the ranking and/or rating algorithms may include ... a consideration of a content piece's **revenue generating potential**, which may be **included as data in the**

> **content descriptors** corresponding to the content piece ... to generate the ranking and/or rating feedback."

The PTO concedes that Payton does not disclose this limitation. Refer to Office Action mailed July 13, 2006, page 29-30, paragraph 10, stating in pertinent part:

> "Payton differs from the claimed invention in that Payton **fails to disclose** wherein the content descriptors include data pertaining to a **revenue-generating potential** of at least a portion of the content pieces, and the ranking algorithm includes **a consideration of** the content piece's **revenue generating potential** when generating the ranking feedback."

The PTO however, asserts that Urakoshi discloses such a limitation and that it would have been obvious to modify Payton to include said limitation. However, Applicant respectfully submits that Urakoshi **does not** disclose such a limitation, and therefore cannot cure the deficiency of Payton.

Urakoshi discloses a method to **sort program listings for viewing** on the basis of **price.** Urakoshi does not disclose a method "**performing a ranking algorithm** ... based at least in part on the content descriptors, **including the data pertaining to the revenue-generating potential**, to generate a ranking feedback," nor does Urakoshi provide any motivation or suggestion for doing so. Refer to Urakoshi column 9, lines 17-27 stating in pertinent part:

> "First, a determination is made as to whether the **price** limit data or the **price** range data is set ... [w]hen they are set, **sort designation** flags stored in the memory [ ] are read out ... [t]here are three different sort designation flags representative of conditions of '**In the order of higher prices**', '**In the order of lower prices**' and '**No price order is set**' ... ."

As is well understood, "price" is not the same thing as "revenue generating potential." Price is defined as "the amount of money given or set as the amount to be given as a consideration for the sale of a specific thing." Webster's Third New International Dictionary

1798 (Unabridged ed. 2002). Conversely, revenue is defined as "the total income produced by a given source." *Id.* at 1942. If one were to consider the "price" of a content piece in the ranking algorithm instead of revenue generating potential, then, by example, a first content piece selling for $1000.00, but having only a potential market of five customers (wherein the revenue generating potential is $5000), would rank far better than a second content piece selling for $5.00, but having a potential market of 100,000 customers (wherein the revenue generating potential is $500,000). In this example, because the "price" of a content piece is used instead of the "revenue generating potential," the higher priced content ranks higher, even though the content with the greater revenue generating potential should rank higher, and would be preferred by content providers and content distributors.

Modifying the present invention in the manner suggested by the PTO, sorting listings by "price" to generate the ranking feedback, has a detrimental effect on the benefits taught by Applicant in the present invention. Urakoshi therefore not only fails to disclose the limitation taught by Applicant, but teaches away from Applicant in an effort to solve a different problem that is not addressed by Applicant in the present invention.

Consequently, Payton fails to disclose each and every element of claim 1, as required under M.P.E.P. § 2131. Independent claims 35, 59, 80, 90, 98, 106, and 113 now include similar novel elements as independent claim 1. Accordingly, Applicant respectfully requests that the instant §102 rejections of claims 1, 35, 59, 80, 90, 98, 106, and 113 be withdrawn.

As to all dependent claims rejected under 35 U.S.C. § 102(b), specifically claims 2-6, 9-10, 12, 14, 18, 21-25, 31, 34, 36-40, 43, 44, 46, 48, 52, 55-58, 60-65, 67, 69, 73, 76-79, 81-85, 87-89, 91-93, 95-97, 99-105, and 107-121, Applicant respectfully submits that all are in condition for allowance as said claims depend on an allowable independent claim. The claims

each incorporate the novel elements of their respective independent claims as discussed immediately above, and therefore each is in condition for allowance. Applicant therefore respectfully requests the withdrawal of the rejection to claims 2-6, 9-10, 12, 14, 18, 21-25, 31, 34, 36-40, 43, 44, 46, 48, 52, 55-58, 60-65, 67, 69, 73, 76-79, 81-85, 87-89, 91-93, 95-97, 99-105, and 107-121.

Claims rejected under 35 U.S.C. § 103(a)

The following claims are rejected under 35 U.S.C. § 103(a): claims 7 and 41 over Payton in view of Kawaguchi; claims 8, 42, 86, and 94 over Payton in view of Perlman; claims 11, 45, and 66 over Payton in view of Urakoshi; claims 13, 15, 16, 26, 28-29, 47, 49-50, 68, and 70-71 over Payton in view of Inoue; claims 20, 33, 54, and 75 over Payton in view of Herz; claims 17, 30, 51, and 72 over Payton in view of McCoy; and claims 19, 32, 53, and 74 over Payton in view of Ismail.

"To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. All words in a claim must be considered in judging the patentability of that claim against the prior art." M.P.E.P. § 2143.03.

Dependent claims 11, 45, and 66 are canceled herein without prejudice, and therefore, the corresponding rejections are rendered moot.

The remaining dependent claims are novel and nonobvious over the prior art of record for at least the same reasons as discussed above in connection with their respective independent claims, in addition to adding further limitations of their own. Accordingly, Applicant respectfully requests that the instant § 103 rejections of the dependent claims be withdrawn.

Conclusion

Given the above amendments and accompanying remarks, all claims pending in the application are in condition for allowance. If the undersigned attorney has overlooked subject matter in any of the cited references that is relevant to allowance of the claims, the Examiner is requested to specifically point out where such subject matter may be found. Further, if there are any informalities or questions that can be addressed via telephone, the Examiner is encouraged to contact the undersigned attorney at (503) 439-8778.

Charge Deposit Account

Please charge our Deposit Account No. 02-2666 for any additional fee(s) that may be due in this matter, and please credit the same deposit account for any overpayment.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

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Gregory D. Caldwell
Attorney for Applicants
Registration No. 39,926

Blakely, Sokoloff, Taylor & Zafman LLP
12400 Wilshire Boulevard, Seventh Floor
Los Angeles CA 90025-1030
Phone: (503) 439-8778
Facsimile: (503) 439-6073